

REMARKS

Applicant has carefully reviewed the Final Office Action of July 27, 2007 in which claims 1, 2, 6-8, 10, 12, 17 and 18 are pending and have been rejected. Favorable consideration of the following remarks is respectfully requested.

Claims 1-2, 8, 10 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schoenholtz, U.S. Patent No. 6,203,534, in view of Cohen, U.S. Patent No. 5,330,521. Applicant respectfully traverses the rejection.

As a preliminary matter, Applicant notes that to rely on a reference under 35 U.S.C. § 103, it must be analogous art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). In the Response to Arguments on page 4 of the Office Action, the Examiner argues that both references "are in the same field of endeavor, both references are implantable electrode catheters...that are reinforced to improve catheter tracking and flexibility. This is incorrect. Cohen teaches a permanently implantable electrical lead; Cohen does not mention catheters, reinforcement or tracking. Where Cohen mentions flexibility, it is talked about in terms of fatigue resistance (see, for example, column 8, lines 50-52), and where Cohen mentions electrodes, it is not as part of the device but rather as something the electrical lead of Cohen may be connected to. Moreover, Cohen is directed to the problem in the field of electrical leads of reducing electrical resistance per unit length while withstanding the high repetitive loads of a beating heart (column 3, lines 46-52). In contrast, Schoenholtz is directed to catheter having a water-resistant protective covering along its length, and some embodiments of Schoenholtz may include temporary therapeutic electrodes as disclosed in prior applications. Further, "Patent Office classification of references and the cross-references in the official search notes of the class definitions are some evidence of "nonanalogy" or "analogy" respectively, the court has found "the similarities and differences in structure and function of the inventions to carry far greater weight." *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). These two references have different classifications and even have non-overlapping fields of search. These two references are structurally and functionally quite different. Schoenholtz is a catheter having four layers and a therapeutic element. Cohen,

by contrast, is a coiled lead with a single insulating sheath. The former is used percutaneously through blood vessels or other bodily lumens to deliver a therapy to a specific location of interest before being withdrawn. The latter is designed to be permanently implanted in a body cavity to deliver electricity from a pace maker or other device to an electrode in a beating heart without suffering fatigue failure. One designing a catheter such as Schoenholtz would not be expected to be aware of the state of the art in electrical leads nor would electrical lead technology commend itself to an invention considering problems in the catheter arts. Applicant therefore respectfully submits that the Cohen reference is not an analogous reference, either to Schoenholtz or to the present application: it is in a different field from Applicant's application and it would not have logically commended itself to the inventor's attention when considering his problem.¹

Applicant further submits that a *prima facie* case of obviousness with regard to Schoenholtz over Cohen has not been made for at least the reason that there is no motivation or suggestion to combine the references.

Schoenholtz is cited as supplying all the claim limitations with the exception of a distal braid section where the cross-sectional area of the continuous wire is less than that in the proximal braid section. The Examiner argues that "it would have been obvious to add the methods and reinforcement member teachings of Cohen to the system of Schoenholtz because as taught in Cohen, the reduction of the core diameter of the reinforcement member allows for tip flexibility and tracking within a patient without overly compromising strength. However, (1) Cohen does not teach a reinforcement member, (2) Cohen does not teach anything about tracking, and (3) Cohen does not teach anything about strength. Element 42 of Cohen is not a wire reinforcement coil, it is a wire core (column 8, line 19). This matters because wire core 42 of Cohen is not analogous to reinforcing member 24 of Schoenholtz; they are different structures

¹ See *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992) (Claims were directed to a process for storing a refined liquid hydrocarbon product in a storage tank having a dead volume between the tank bottom and its outlet port wherein a gelled solution filled the tank's dead volume to prevent loss of stored product while preventing contamination. One of the references relied upon disclosed a process for reducing the permeability of natural underground hydrocarbon bearing formations using a gel similar to that of applicant to improve oil production. The court disagreed with the PTO's argument that the reference and claimed inventions were part of the same endeavor, "maximizing withdrawal of petroleum stored in petroleum reserves," and found that the inventions involved different fields of endeavor since the reference taught the use of the gel in a different structure for a different purpose under different temperature and pressure conditions, and since the application related to storage of liquid hydrocarbons rather than extraction of crude petroleum. The court also found the reference was not reasonably pertinent to the problem with which the inventor was concerned because a person having ordinary skill in the art would not reasonably have expected to solve the problem of dead volume in tanks for refined petroleum by considering a reference dealing with plugging underground formation anomalies.). (From MPEP 2141.01(a).)

that perform different functions. This makes it substantially less likely that one would substitute one for another without a specific teaching. And Cohen, so far as Applicant can determine, does not include a specific teaching which would cause one of skill in the art to modify Schoenholtz in view of it. The teaching of Cohen with regard to its variable diameter lead is that the distal portion, which has the smaller cross-sectional core diameter, provides better fatigue resistance while the proximal portion with the large cross-sectional core diameter provides reduced electrical resistance. See column 8, lines 49-62. Nothing is taught about the trackability of the lead, and nothing is taught about the strength of the lead. Further, flexibility is taught only with respect to fatigue resistance, which is not a feature that Schoenholtz discusses. Cohen, therefore, teaches no benefits to its electrical lead design by which a person of skill in the art would modify a catheter as taught by Schoenholtz.

For at least these reasons, Applicant respectfully submits that claim 1 is in condition for allowance. As claims 2 and 8 depend from claim 1 and contain additional elements, Applicant respectfully submits that these claims are in condition for allowance as well. As independent claim 10 recites “the distal cross-sectional area of each of the continuous wires is less than the proximal cross-sectional area of each of the continuous wires,” Applicant respectfully submits that claim 10 is in condition for allowance for at least the reasons given above with respect to claim 1. As claim 12 depends from claim 10 and contains additional elements, Applicant respectfully submits that this claim is in condition for allowance as well.

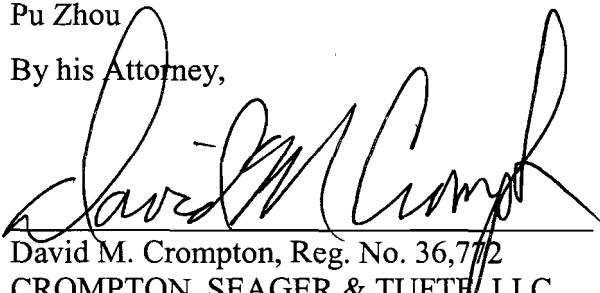
Claims 6-7 and 17-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schoenholtz in view of Cohen. Applicant respectfully traverses the rejection.

Applicant respectfully submits that these claims are allowable for at least the reason that they depend from claims 1 or 10, which are allowable, and because they contain additional elements.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By his Attorney,



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